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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,712	10/10/2001	Carl Johan Friddle	LEX-0251-USA	7859

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LEXICON GENETICS INCORPORATED  
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EXAMINER

LANDSMAN, ROBERT S

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 12/17/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/974,712

Applicant(s)

FRIDDLE ET AL.

Examiner

Robert Landsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☒ Other: *Sequence Comparisons A and B*.

## DETAILED ACTION

### *1. Formal Matters*

- A. Claims 1-4 are pending in the application and were subject to restriction in Paper No. 6, dated 9/30/02. In Paper No. 7, dated 11/4/02, Applicants elected Group I, claims 1-3, without traverse. Therefore, claims 1-3 are the subject of this Office Action.
- B. The Information Disclosure Statement, filed 1/31/02, has been entered into the record.
- C. While not the basis for a rejection or objection, the syntax of claim 1 could be improved by replacing the phrase "described in" with "of."
- D. While not the basis for a rejection or objection, the syntax of claims 2 and 3 could be improved by replacing the phrase "shown in" with "of."
- E. Though not the subject of a rejection, or objection, for claim 2 to be more clear, Applicants should amend part (b) of this claim to recite "full complement," so as not to be interpreted as a complement to less than the entire length of the nucleic acid molecule of SEQ ID NO:1.

### *2. Specification*

- A. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The present title is "Novel human ion channel proteins and polynucleotides encoding the same." First, the word "novel" should be omitted from the title, since all patents contain novel subject matter. Second, the claims are drawn toward polynucleotides encoding human ion channel proteins and not to the proteins themselves. Therefore, the title should be amended to, for example, "Polynucleotides encoding human ion channel proteins."

- B. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

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The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

### ***3. Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by a specific and substantial asserted utility, or a well established utility. These claims are directed to an isolated nucleic acid comprising SEQ ID NO:1, nucleic acid molecules which encode the protein of SEQ ID NO:2, and which hybridize to SEQ ID NO:1, or to the complement thereof. However, the invention encompassed by these claims has no apparent or disclosed patentable utility. This rejection is consistent with the current utility guidelines (published 1/5/01, 66 FR 1092). The instant application has provided a nucleotide (SEQ ID NO:1) and protein (SEQ ID NO:2) sequence. However, the instant application does not disclose a specific and substantial biological role of the nucleic acid molecule of SEQ ID NO:1, the protein of SEQ ID NO:2, or their significance. Therefore, no specific and substantial utility of these nucleic acid molecules, or protein can be asserted.

It is clear from the instant specification that the claimed receptor is what is termed an "orphan receptor" in the art. Applicants disclose in the specification that the receptor encoded for by the claimed nucleic acid molecule is believed to encode a protein (termed "NHP" for "novel human protein") related to voltage-gated potassium channels (page 2, lines 1-5). However, the basis that the receptor is disclosed in the specification to be homologous to these ion channels is not predictive of use. There is little doubt that, after complete characterization, this protein will probably be found to have a patentable utility. This further characterization, however, is part of the act of invention and, until it has been undertaken, Applicants' claimed invention is incomplete.

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The instant situation is directly analogous to that of which was addressed in *Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct, 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anticancer activity was alleged to be potentially useful as an antitumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are “useful” to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of “useful” as it appears in 35 U.S.C. 101, which required that an invention must have either an immediate obvious or fully disclosed “real-world” utility. The court held that:

“The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility,” “[u]nless and until a process is refined and developed to this point - where specific benefit exists in currently available form - there is insufficient justification for permitting an applicant to engross what may prove to be a broad field,” and “a patent is not a hunting license,” “[i]t is not a reward for the search, but compensation for its successful conclusion.”

The specification discloses that the polynucleotide of the invention (SEQ ID NO:1) encodes a protein which is “shares structural similarity with mammalian...voltage-gated potassium channels.” However, this is not a specific and substantial asserted utility, or a well established utility of the protein of the instant specification. No comparisons between the sequence of the protein of the present invention and any voltage-gated potassium channel protein have been disclosed in the specification, nor does the specification disclose that the protein encoded for by the polynucleotide of the present invention has biological activities similar to these channels. Sequence homology alone cannot be accepted in the absence of supporting evidence, because the relevant literature acknowledges that function cannot be predicted based solely on structural similarity to a protein found in the sequence databases.

For example, Skolnick et al. (Trends in Biotech. 18:34-39, 2000) state that knowing the protein structure by itself is insufficient to annotate a number of functional classes, and is also insufficient for annotating the specific details of protein function (see Box 2, p. 36). Similarly, Bork (Genome Research 10:398-400, 2000) states that the error rate of functional annotations in the sequence database is considerable, making it even more difficult to infer correct function from a structural comparison of a new sequence with a sequence database (see especially p. 399). Such concerns are also echoed by Doerks et al. (Trends in Genetics 14:248-250, 1998) who state that (1) functional information is only partially annotated in the database, ignoring multi functionality, resulting in underpredictions of functionality of a new protein and (2) overpredictions of functionality occur because structural similarity often does not necessarily coincide with functional similarity. Smith et al. (Nature Biotechnology 15:1222-1223, 1997)

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remark that there are numerous cases in which proteins having very different functions share structural similarity due to evolution from a common ancestral gene.

Brenner (Trends in Genetics 15:132-133, 1999) argues that accurate inference of function from homology must be a difficult problem since, assuming there are only about 1000 major gene superfamilies in nature, most homologs must have different molecular and cellular functions. Finally, Bork et al. (Trends in Genetics 12:425-427, 1996) add that the software robots that assign functions to new proteins often assign a function to a whole new protein based on structural similarity of a small domain of the new protein to a small domain of a known protein. Such questionable interpretations are written into the sequence database and are then considered facts. Therefore, based on the art's recognition that one cannot rely upon structural similarity alone to determine functionality, the specification fails to teach the skilled artisan the utility of the claimed polynucleotide of SEQ ID NO:1, which is only known to encode a protein which is similar to mammalian voltage-gated potassium channels.

Therefore, the instant claims are drawn to a nucleic acid molecule which has a yet undetermined function or biological significance. There is no actual and specific significance which can be attributed to said nucleic acid molecule, or encoded protein, identified in the specification. For this reason, the instant invention is incomplete. In the absence of a knowledge of the natural ligands or biological significance of this protein, or any significance of the nucleic acid molecule of the present invention, which has not been disclosed in the specification as having any specific or substantial utility, there is no immediately obvious patentable use for them. To employ the nucleic acid molecule of the instant invention to produce a receptor protein to identify substances which bind to and/or mediate activity of the said receptor is clearly to use it as the object of further research which has been determined by the courts to be a non-patentable utility. Since the instant specification does not disclose a "real-world" use for the nucleic acid molecule of the invention, then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 U.S.C. 101 as being useful.

**Therefore, since the nucleic acid molecule of the invention (SEQ ID NO:1), nor its encoded protein (SEQ ID NO:2), are supported by a specific and substantial asserted utility, or a well established utility, then polynucleotides encoding SEQ ID NO:2, as well as expression vectors comprising these nucleic acid molecule also do not possess utility.**

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**4. Claim Rejections - 35 USC § 112, first paragraph - enablement**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

A. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to adequately teach how to use the instant invention. Specifically, since the claimed invention is not supported by a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

**5. Claim Rejections - 35 USC § 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim recites "stringent conditions." However, the metes and bounds of this phrase are not known. What one in the art considers highly stringent, another may not. Therefore, it is suggested that part (b) of claim 2 be deleted since this limits the scope of the claim. If Applicants wish to keep part (b) in the claim, they should amend the claim to recite the exact hybridization conditions as found, for example, on page 4, lines 25-29 of the specification.

**6. Closest Prior Art**

A. No prior art teaches an isolated polynucleotide of SEQ ID NO:1, or one which encodes the protein of SEQ ID NO:2. However, Chandy et al. (US Patent No. 5,559,009) teach a polynucleotide which is 72.6% identical to that of SEQ ID NO:1 (Sequence Comparison).

**7. Conclusion**

A. No claim is allowable.

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***Advisory information***

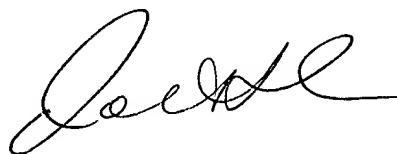
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.  
Patent Examiner  
Group 1600  
December 16, 2002

A handwritten signature in black ink, appearing to read 'Robert Landsman', with a stylized, cursive script.